

REMARKS

Claims 9-14 and 30-34 are currently pending in the application, of which claims 9 and 31 are independent claims.

In view of the following Remarks, Applicants respectfully request reconsideration and timely withdrawal of the pending objections and rejections for the reasons discussed below.

Drawing Objection

In the Office Action, the Figure 7 was objected to as not showing “areas with high surface energy and areas with low surface energy.” Applicants respectfully traverse this rejection. There is no requirement that each figure show all of the aspects, features, or elements of the invention. Thus, assuming *arguendum* that the Examiner has correctly characterized the claim language, there is no need for this language to be reflected in Figure 7. However, to further expedite prosecution, Applicants have provided a revised Figure 7 in which reference number 75 denotes a low surface energy area of the PDL. The remainder of element 115, excluding the area labeled by reference number 75 may be a high surface energy area.

Accordingly, Applicants respectfully request withdrawal of the drawing objection.

Rejections Under 35 U.S.C. §102

Claims 31-34 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application No. 2004/0175646 of Hatanaka, *et al.* (“*Hatanaka*”). Applicants respectfully traverse this rejection for at least the following reasons.

Hatanaka is improper prior art because the present invention claims the priority of German Patent Application No. 102 36 404.4, filed August 2, 2002. In contrast *Hatanaka* was not filed in the U.S., but was filed in Japan in the Japanese language under PCT/JP02/07178. The publication language under Article 21(2) was Japanese as well, and the application published in Japanese February 13, 2003. Accordingly, the reference is not prior art under 35 U.S.C. §102(e) because that section specifies that PCT applications are prior art “only if the international application designated the United States and was published under Article 21(2) of [the PCT] treaty in the English language.” 35 U.S.C. §102(e).

Rejections Under 35 U.S.C. §103

Claims 9-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Hatanaka* in view of U.S. Patent Application No. 2004/0009673 of Sreenivasan, *et al.* (“*Sreenivasan*”). Applicants respectfully traverse this rejection for at least the following reasons.

In order to render a claim obvious, the combination of cited references must teach each and every element of the claimed invention and must provide teaching, motivation or suggestion to combine. Nat'l Steel Car, Ltd. v. Canadian Pac. Rwy., 357 F.3d 1319, 1337 (Fed. Cir. 2004) (citing Ecologchem, Inc. v. S. Cal. Edison Co., 227 F.3d 1361, 1371 (Fed. Cir. 2000)). This motivation must be based on the knowledge in the art, not knowledge provided by the application under examination, because such hindsight reconstruction is forbidden. In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

The combination of *Hatanaka* and *Sreenivasan* is not proper because, as explained above, *Hatanaka* is not proper prior art.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection of claims 9-14. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicants respectfully submit that independent claim 9, and all the claims that depend from it are allowable.

Other Matters

Claim 30 is identified as rejected in the summary page of the office action. On page 4, claim 30 is not included within the claims rejected under 102 or under 103. On page 5 of the Office Action, the Examiner observes that product-by-process claims cover the product. The Examiner further asserts that the claim does not distinguish over *Hatanaka* or *Sreenivasan* because only the final product is relevant. However, the Examiner does not identify what that product is, nor does the Examiner show that each element of the claimed invention is taught by the cited references. Accordingly, Applicants respectfully request the withdrawal of the rejection of claim 30.

CONCLUSION

Applicants believe that a full and complete response has been made to the pending Office Action and respectfully submits that all of the stated objections and grounds for rejection have been overcome or rendered moot. Accordingly, Applicants respectfully submit that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicants' undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

Richard Schaefer, P.O.
Hae-Chan Park *Reg. No. 48,342*
Reg. No. 50,114

Date: March 22, 2005

McGuireWoods LLP
1750 Tysons Boulevard
Suite 1800
McLean, VA 22102-4215
Tel: 703-712-5365
Fax: 703-712-5280
HCP:PCF/tmf

AMENDMENTS TO THE DRAWINGS

Attached hereto is a replacement figure sheet for Figure 7, which includes the changes, without markings, identified below.

Figure 7 has been amended to include reference numeral 75, which denotes a low surface energy area of the PDL 115.